

12179-P064US



PATENT

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application: Tolt, et al.
Serial No.: 08/859,960
Filed: May 21, 1997
Art Unit: 1765
Examiner: R. Kunemund
For: PROCESS FOR GROWING A CARBON FILM

REPLY BRIEF

Assistant Commissioner for Patents
Washington, D. C. 20231

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CERTIFICATION UNDER 37 C.F.R. § 1.8

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The Examiner has not agreed with Appellants' statement in the Appeal Brief that certain claims do not stand or fall together because the separate groups contain the same claims and the groupings do not include all pending claims. In response, Appellants hereby group claims 1-8, 10-11, 13-17 and 20-26 as a first group, claim 9 as a second group, and claims 12 and 18-19 as a third group.

In response to the Examiner's arguments in Section 11 on page 4 of Paper No. 11, whereby the Examiner has asserted that he has met the requirements of MPEP § 2112, Appellants respectfully traverse. The Examiner has yet to meet his burden under MPEP § 2112. Therein it states that the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. The only evidence the Examiner has provided is his own opinion that the teachings in the *Song* reference may result in the claimed invention. The Examiner's own opinion and reasoning is not a sufficient showing of a basis in fact and/or technical reasoning to reasonably support his determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.

Quite clearly, the Examiner's own opinion does not amount to a basis in fact. An Examiner's opinion is just that, a subjective opinion. To provide a basis in fact, the Examiner would be required to cite some other prior art reference to support his opinion.

Furthermore, Appellants respectfully assert that the Examiner's own opinion does not amount to a sufficient line of technical reasoning that reasonably supports his inherency argument. Again, the Examiner's assertions are his own opinion. The Examiner has provided no evidence that he is in any way an expert in the field of growing carbon films for field emitter devices. With all due respect to the Examiner, merely being an examiner in the PTO does not mean that that examiner is an expert in a particular field, nor does it even equate to the examiner being one skilled in the art in that field.

Broad conclusory statements regarding the prior art, standing alone, are not "evidence." *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). It is respectfully asserted that for the Examiner to meet his burden under MPEP § 2112, the Examiner must support his inherency with objective evidence, which is not an Examiner's subjective opinion, in order to show that the inherent characteristic necessarily flows from the teachings of the applied prior art. The standard for proving obviousness and inherency arguments by an Examiner must be the provision of objective evidence. Otherwise, every Examiner could merely rely upon his own opinion to prevent any patent from every being allowed.

As a result, Appellants respectfully assert that the burden under MPEP § 2112 has not yet shifted to Appellants.

In response to Appellants' arguments that the claims 1, 14, 17 and 26 recite that the carbon film is grown on the substrate and that *Song* does not in any way teach or suggest that it shows emitter material 370 grown on the substrate 310, since a ballast material 365 is first deposited on the substrate before the emitter material 370 is deposited on the ballast material 365, the Examiner has asserted that the claims do not exclude the use of the ballast material. Appellants agree that a ballast material is not excluded from these claims; however, the claims do specifically recite that the carbon film is grown on the treated substrate. Quite clearly, if a prior art reference grows a carbon film on a ballast, which is deposited on a substrate, then this prior art reference does not teach or suggest growing of the carbon film on the substrate. Again, with all due respect to the Examiner, the Examiner's reasoning is flawed.

The Examiner then goes on to state that the change in the substrate would in fact propagate to the ballast material and thus affect the carbon emitter. First of all, this is an unsupported opinion by the Examiner, and has no basis in fact. Secondly, what would it even matter if this were true? As far as the claims are concerned, a carbon film is grown on the treated substrate. This is the claim limitation that the Examiner must address.

Appellants' same arguments apply with respect to claims 12 and 18. Again, the Examiner has responded by stating that the claims allow for an intervening layer, such as a ballast layer. The Examiner's reasoning is flawed. The claims recite that the carbon film is deposited on the metal layer. This step is not taught or suggested within the prior art reference. These steps within the claims do not allow for an intervening layer when they state the carbon film is deposited on the metal layer.

For the above reasons, it is respectfully asserted that all of the claims in the Application are allowable over the cited prior art.

Respectfully submitted,
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